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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,648	03/07/2001	Stacey J. Swart	10004942-1	3330

7590 03/29/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER	
HUTTON JR, WILLIAM D	

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/800,648	Applicant(s) SWART ET AL.	
	Examiner Doug Hutton	Art Unit 2179	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of 11. does NOT place the application in condition for allowance because: In the non-Final Office Action dated 1 July 2004, the previous version of Claims 1-20 of the present application were rejected under 35 USC 102(e) as being anticipated by http://web.archive.org/web/20000815094608/http://www.adobe.com/products/framemaker/sgmlwhatsnew.html (hereinafter, Adobe), as it appeared on 15 August 2000. In the response dated 4 October 2004, Applicant amended the claims and argued that the amendments distinguished the present invention from Adobe. No 131 declaration was submitted with Applicant's response.

In the Final Office Action dated 11 January 2005, the current version of Claims 1-5, 8-14 and 17-24 were rejected under 35 USC 103 as being unpatentable over Adobe, in view of http://web.archive.org/web/20000914072847/nocookie.quadralay.com/products/wwp_pro/default.asp (hereinafter, WebWorks Publisher), as it appeared on 14 September 2000. In the response dated 14 March 2005, Applicant sumitted a declaration under 37 CFR 1.131 allegedly establishing that the claimed inventions were conceived of and reduced to practice prior to 15 August 2000. With the 131 declaration, Applicant is attempting to antedate both Adobe and WebWorks Publisher.

Under MPEP 715.09, affidavits and declarations under 37 CFR 1.131 must be timely presented in order to be admitted. A 131 declaration may be timely admitted if submitted after final rejection and submitted with a first reply after final rejection for the purpose of overcoming a new ground of rejection made in the final rejection.

In this instance, the publication date of Adobe was clearly indicated in the non-Final Office Action and the option of antedating Adobe was available to Applicant. Instead, Applicant chose to argue that the amendments to the claims distinguished the invention from Adobe. Now, upon learning that the prior art discloses and teaches every limitation of the amended claims, Applicant has selected a different mode of obviating the rejections. WebWorks Publisher was published more recently than was Adobe. Thus, the ground for rejection in the Final Office Action is not "new" and a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195 is required.

Accordingly, the 131 declaration will not be entered because Applicant has failed to provide a showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented.

Moreover, the declaration fails to antedate the prior art references.

Firstly, the 131 declaration fails to show that the invention has been sufficiently tested to demonstrate that it worked for its intended purpose. For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985). The 131 declaration mentions nothing about the invention being tested to ensure that it would work for its intended purpose. Instead, the 131 declaration conclusively states that "the file generating apparatus successfully converted SGML documents into HTML documents using customized style templates for defining the styles of various EDD elements (see Paragraph #3). Although Exhibit H answers "yes" to question of whether the invention was "built or tested," this is neither an affirmative statement that the invention was ever tested nor proof that the invention was "sufficiently tested" to demonstrate that it woked for its intended purpose.

Secondly, although the 131 declaration includes HTML filenames that are alleged results of the invention, it fails to show the corresponding SGML input files that were converted by the invention ever existed. That is, Exhibit C allegedly shows HTML files that were converted into HTML from respective SGML files by the invention; however, there is no evidence to show that these "respective SGML files" ever existed.

Thirdly, the 131 declaration fails to mention the "first logic," the "technical writing tool algorithm" and the "second logic," as claimed in Claim 1 (see Lines 2 and 9). Thus, the 131 declaration fails to show whether these elements of the claimed invention have ever existed.

Accordingly, the declaration fails to antedate the prior art references.